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In re Application of	:	
VATANEN	:	DECISION ON PETITION
Serial No.: 09/868,387	:	
PCT No.: PCT/FI91/01036	:	UNDER 37 CFR 1.47(b)
Int. Filing Date: 15 December 1999	:	
Priority Date: 16 December 1998	:	
Atty Docket No.: 2132-47PCON	:	
For: METHOD AND SYSTEM FOR	:	
IMPLEMENTING A DIGITAL	:	
SIGNATURE	:	

This decision is in response to the petition under 37 CFR 1.47(b) filed 25 February 2002 to accept the application without the signature of inventor Harri VATANEN.

BACKGROUND

On 15 December 1999, applicant filed international application PCT/FI99/01036. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 06 July 2000. A Demand for international preliminary examination, in which the United States was elected was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 16 June 2001.

On 18 June 2001, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a preliminary amendment and a translation of the International Application into English. An oath or declaration as required by 35 U.S.C. 371 (c)(4) was not filed.

On 25 July 2001, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) and a NOTIFICATION OF DEFECTIVE OATH OR DECLARATION (Form PCT/DO/EO/917) informing applicant of the need to provide an executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. In addition, applicant was notified of the need to provide a surcharge of \$130.00 for filing the oath or declaration later than the appropriate 20 or 30 months from the earliest priority date. (37 CFR 1.492(e). Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 25 February 2001, applicant responded with the present petition accompanied by a petition for a five-month extension of time, a check in the amount of \$1,890.00 as payment of the five month extension fee, a check in the amount of \$130.00 as payment of the surcharge for providing an executed oath or declaration of the inventor later than thirty months from the earliest claimed priority date and a check in the amount of \$130.00 as payment of the fee for the present petition.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(I); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the non-signing inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as an agent for the non-signing inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. Applicant has satisfied items (1), (3), (4) and (6).

As to item (2), as stated in the Manual of Patent Examination Procedure (MPEP), Section 409.03(d) Proof of Unavailability or Refusal, "Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature." The enclosed declaration of Paivi Soderman (applicant's exhibit 4) does not provide any specific details nor documentation regarding the purported delivery of the declaration and specification to Mr. Vatanen nor the nature of his alleged promises to execute the declaration. In addition, it is unclear from the declaration how much first-hand knowledge Ms. Soderman has of the events detailed as she states that, "We delivered..." and "...in spite of the fact that we have forwarded..."

Regarding item (5) above, applicant has not provided any proof that the subsidiary, Sonera Smarttrust Oy, has a proprietary interest in the inventions of Mr. Vatanen as his assignment is to the parent corporation Sonera Oy. A copy of the assignment from Sonera Oy to Sonera Smarttrust Oy as referenced in Mr. Simmelvuo's declaration should be submitted.

In light of the above, it is not possible to grant applicant's petition at this time.

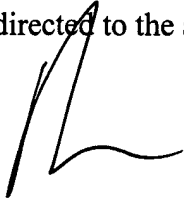
CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a

cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter directed to the attention of the PCT Legal Office.



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